



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Osamu UENO et al.

Group Art Unit: 2827

Application No.: 09/805,250

Examiner: T. Dinh

Filed: March 14, 2001

Docket No.: 108910

For: CIRCUIT BOARD DEVICE AND DESIGN SUPPORT DEVICE

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the March 25, 2005 Election of Species Requirement, Applicants provisionally elect Species I, Figure 1, with traverse. Claims 1-3, 5-9, 21, 25, and 26 read on elected Species I. However, Applicants respectfully submit that the Election of Species Requirement is improper for at least the following reasons.

MPEP §806.04(f) requires that species must be mutually exclusive. That is, each species must explicitly exclude at least one feature of the remaining species. The alleged species identified above are not mutually exclusive. For example, Species I (Figure 1, the first embodiment) does not exclude the possibility of a capacitor and resistor included in the terminal element, which seems to be the basis for Species II (Figures 2-3 and 8-11, the second embodiment). Thus, Species I does not explicitly exclude any features of Species II and is improper under MPEP §806.04(f). This is evidenced by the fact that dependent claims 5 and 6, reciting features of the second embodiment, depend from claim 1, reciting features of the first embodiment.

The Election of Species Requirement defines Species III as Figs. 4, 5, and 7, disclosing the third embodiment, but includes a separate embodiment shown in Figs. 14A-14D and having a single power supply surface. Applicants are unable to discern the Election of Species' rationale for grouping these figures together, because Figs. 14A-14D depict a separate embodiment from the remaining Figs. 1-5 and 7-11. For example, the first, second, and third embodiments (Figs. 1-5, 7-11, and claims 1-3, 5-9, 21, 25, and 26) require at least two power supply regions, while the separate embodiment (Figs. 14A-14D, claims 15-20, 22-24, 27, and 28) requires a single power supply region.

The third embodiment shown in Figures 4, 5, and 7 is not mutually exclusive from either of Species I or Species II. However, we believe that the separate embodiment shown in Figs. 14A-14D is mutually exclusive from the first, second, and third embodiment.

For example, the third embodiment (Figs. 4, 5, and 7, claims 25-28) further specifies the location of the terminal elements. These locations are not inconsistent with Species I or Species II because the location of the terminal elements in Species I and II (at a terminal end of said at least one region) does not conflict with their location according to Species 3 (only at a terminal end of said at least one region, and not at an outer periphery edge of said power supply region and said ground supply region). This is evidenced by the fact that claims 25 and 26, directed to Species III depend from claim 1, directed to both of Species I and II. Thus, the third embodiment (Figs. 4, 5, and 7, claims 25-28) is not mutually exclusive from either of Species I or Species II.

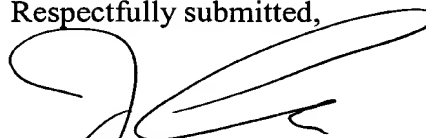
The separate embodiment shown in Figs. 14A-14D (claims 15-20, 22-24, 27, and 28) specifies that the power supply region comprises a single power supply surface. This appears to be inconsistent with each of the first, second, and third embodiments, which specifically exclude a single power supply region, by requiring that the power supply is split into two or more power supply regions. Thus, the alternative embodiment of Figs. 14A-14D (claims 15-20, 22-24, 27, and 28) appears to be a separate species from as single species including the first, second, and third embodiments (Figs. 1-5 and 7-11, and claims 1-3, 5-9, 21, 25, and 26).

Finally, the Election of Species requirement fails to address Figs. 15-24 and fails to address Figs. 4, 5, and 7 with respect the sub-species.

Applicants also respectfully submit that the subject matter of all of the alleged species is sufficiently related that a thorough search for the subject matter of any one species would encompass a search for the subject matter of the remaining species. Each of the alleged species are classified in the same class and subclasses. Thus, a thorough search for the subject matter of any one species must encompass a search for the subject matter of the remaining species. Furthermore, Examiner Dinh has in fact searched the subject matter of all of the alleged species since at least August 29, 2002, over the course of more than 2.5 years, when the first substantive action was issued. Thus, Applicants respectfully submit that the search and examination of the entire application, has been, and can continue to be made without serious burden. See MPEP §803 that states "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). Applicants respectfully submit that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, Applicants respectfully request withdrawal of the Election of Species Requirement.

Respectfully submitted,



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